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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,644	11/21/2003	Ben Montano	BRY-002.01	1261
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FOLEY HOAG, LLP				CHAMBERS, MICHAEL S
PATENT GROUP, WORLD TRADE CENTER WEST				ART UNIT
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BOSTON, MA 02110				3711

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/719,644	MONTANO ET AL.	
	Examiner Mike Chambers	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-27 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: ____.                                    |

## DETAILED ACTION

### ***Claim Objections***

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "a range of pitch angles" is vague and indefinite. One of ordinary skill in the art would not be able to determine the metes and bounds of the invention.

Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "grabbing a lacrosse ball" is vague and indefinite. One of ordinary skill in the art would not be able to determine the metes and bounds of the invention.

Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The terms "substantially polygonal shapes, substantially oval shapes substantially semi-oval shapes" are vague and indefinite. One of ordinary skill in the art would not be able to determine the metes and bounds of the invention.

Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "a round rock" is vague and indefinite. One of ordinary skill in the art would not be able to determine the metes and bounds of the invention.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-17 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hoult (3702702). Hoult discloses a two sidewalls extending outward from the two side surfaces of the throat and connected by the transverse wall, wherein at least one of the sidewalls and an adjacent side surface of the throat are sized, shaped, and positioned for stably rolling a lacrosse ball along at least a portion of the length of the at least one of the sidewalls and onto the adjacent side surface, the portion of the length including more than one half the length (fig 2). It would have been obvious matter of design choice to a person of ordinary skill in the art at the time of the invention to have employed the lacrosse head with a sidewall positioned for stably rolling a ball because the applicant has not disclosed this limitation provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either the cited prior

art or the instant invention because both devices perform the same function. Therefore it would have been an obvious matter of design choice to modify the cited art to include the claimed instant invention as claimed.

As to claim 2 : Hoult discloses an upper and lower arm and connecting portion (fig 2).

As to claims 3 and 4 : Hoult discloses a connecting portion which permit rolling a ball without contacting the connecting portion (fig 2).

As to claim 5 : Hoult discloses a length that is substantially the entire length (fig 2).

As to claim 6 : Hoult discloses upper and lower arms (fig 2).

As to claims 7-9, 11-13,14-16 : The specification provides no unexpected or surprising results in using the cited limitations . It would have been obvious to one of ordinary skill in the art to have selected any one of several equivalent roll angles based on the experience of the designer, or cost and design considerations.

As to claim 10: Hoult discloses a bases and rails (fig 2).

As to claim 17: Hoult discloses a molded plastic head (fig 2, 2:13-16).

Also,

Claims 1-13, and 17-23 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Collinson (6213901). Collinson discloses a two sidewalls extending outward from the two side surfaces of the throat and connected by the transverse wall, wherein at least one of the sidewalls and an adjacent side surface of the throat are sized, shaped, and positioned for stably rolling a lacrosse ball along at least a portion of the length of the at least one of the sidewalls and onto the adjacent side surface, the portion of the length including more than one half the length (fig 1,2). . It would

have been obvious matter of design choice to a person of ordinary in the art at the time of the invention to have employed the lacrosse head with a sidewall positioned for stably rolling a ball because the applicant has not disclosed this limitation provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either the cited prior art or the instant invention because both devices perform the same function. Therefore it would have been an obvious matter of design choice to modify the cited art to include the claimed instant invention as claimed.

As to claim 2: Collinson discloses an upper and lower arm and connecting portion (fig 1,2).

As to claims 3 and 4: Collinson discloses a connecting portion which permit rolling a ball without contacting the connecting portion (fig 1,2).

As to claim 5: Collinson discloses a length that is substantially the entire length (fig 1,2).

As to claim 6 : Collinson discloses upper and lower arms (fig 1,2). The specification provides no unexpected or surprising results in using the cited limitations. It would have been obvious to one of ordinary skill in the art to have selected any one of several equivalent roll angles based on the experience of the designer, or cost and design considerations.

As to claims 7-9: The specification provides no unexpected or surprising results in using the cited limitations . It would have been obvious to one of ordinary skill in the art to select any one of several equivalent roll angles based on the experience of the designer, or cost and design considerations.

As to claim 10 : Collinson discloses a bases and rails (fig 1,2).

As to claims 11-12 : Collinson discloses a convex shape (fig 1,2). The cross section would naturally be convex in shape. And the throat has a convex shape. The specification provides no unexpected or surprising results in using the cited limitations. It would have been obvious to one of ordinary skill in the art to select any one of several equivalent roll angles based on the experience of the designer, or cost and design considerations.

As to claim 13 : Collinson discloses a concave shape (fig 1,2).

As to claim 17 : Collinson discloses a molded plastic head (fig 2, 1:57-58).

As to claims 18-19, : See claim 1 rejection.

As to claims 20-22: Collinson discloses a upper and lower arm and connecting portion that can roll a ball without contacting a connecting portion (fig 2). The specification provides no unexpected or surprising results in using the cited limitations. It would have been obvious to one of ordinary skill in the art to select any one of several equivalent designs based on the experience of the designer, or cost and design considerations.

As to claim 23 : See claim 1 rejection. The length limitation is a design choice. The specification provides no unexpected or surprising results in using the cited limitations. It would have been obvious to one of ordinary skill in the art to select any one of several equivalent designs based on the experience of the designer, or cost and design considerations.

Also,

Claims 1-27 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Morrow (6066056). Morrow discloses a

two sidewalls extending outward from the two side surfaces of the throat and connected by the transverse wall, wherein at least one of the sidewalls and an adjacent side surface of the throat are sized, shaped, and positioned for stably rolling a lacrosse ball along at least a portion of the length of the at least one of the sidewalls and onto the adjacent side surface, the portion of the length including more than one half the length (fig 1,2). It would have been obvious matter of design choice to a person of ordinary skill in the art at the time of the invention to have employed the lacrosse head with a sidewall positioned for stably rolling a ball because the applicant has not disclosed this limitation provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either the cited prior art or the instant invention because both devices perform the same function. Therefore it would have been an obvious matter of design choice to modify the cited art to include the claimed instant invention as claimed.

As to claim 2:Morrow discloses an upper and lower arm and connecting portion (fig 2).

As to claims 3 and 4 : Morrow discloses a connecting portion which permit rolling a ball without contacting the connecting portion (fig 2).

As to claim 5 : Morrow discloses a length that is substantially the entire length (fig 2).

As to claim 6 : Morrow discloses upper and lower arms (fig 2). The specification provides no unexpected or surprising results in using the cited limitations . It would have been obvious to one of ordinary skill in the art to have selected any one of several equivalent roll angles based on the experience of the designer, or cost and design considerations.

As to claims 7-9, 11-13,14-16, : The specification provides no unexpected or surprising results in using the cited limitations . It would have been obvious to one of ordinary skill in the art to select any one of several equivalent roll angles based on the experience of the designer, or cost and design considerations.

As to claim 10 : Morrow discloses a bases and rails (fig 2).

As to claims 11-12 : Morrow discloses a convex shape (fig 2). The cross section would naturally be convex in shape. And the throat has a convex shape. The specification provides no unexpected or surprising results in using the cited limitations. It would have been obvious to one of ordinary skill in the art to select any one of several equivalent roll angles based on the experience of the designer, or cost and design considerations.

As to claim 13 : Morrow discloses a concave shape (fig 1,2).

As to claim 14 : Morrow discloses projections (fig 1,2 item 54).

As to claim 15 : Morrow discloses projections separated by a width less than the diameter of a lacrosse ball (fig 1,2 item 54).

As to claim 16 : Morrow discloses a semi-oval shape (fig 2,4).

As to claim 17 : Morrow discloses a molded plastic head (fig 2, 3:1-2).

As to claims 18-19, 24 : See claim 1 rejection.

As to claims 20-22: Morrow discloses a upper and lower arm and connecting portion that can roll a ball without contacting a connecting portion (fig 2,4). The specification provides no unexpected or surprising results in using the cited limitations. It would have been obvious to one of ordinary skill in the art to select any one of several equivalent designs based on the experience of the designer, or cost and design considerations.

As to claim 23 : See claim 1 rejection. The length limitation is a design choice. The specification provides no unexpected or surprising results in using the cited limitations. It would have been obvious to one of ordinary skill in the art to select any one of several equivalent designs based on the experience of the designer, or cost and design considerations.

As to claim 25: Morrow discloses projections separated by a width less than the diameter of a lacrosse ball (fig 1,2 item 54).

As to claim 26 : Morrow discloses a semi-oval shape(fig 2,4).

As to claim 27 : Morrow discloses a molded plastic head (fig 2, 3:1-2).

Also,

Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over LeMire (20020107094). LeMire discloses a two sidewalls extending outward from the two side surfaces of the throat and connected by the transverse wall, wherein at least one of the sidewalls and an adjacent side surface of the throat are sized, shaped, and positioned for stably rolling a lacrosse ball along at least a portion of the length of the at least one of the sidewalls and onto the adjacent side surface, the portion of the length including more than one half the length (fig 1,3b). It would have been obvious matter of design choice to a person of ordinary skill in the art at the time of the invention to have employed the lacrosse head with a sidewall positioned for stably rolling a ball because the applicant has not disclosed this limitation provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either

the cited prior art or the instant invention because both devices perform the same function. Therefore it would have been an obvious matter of design choice to modify the cited art to include the claimed instant invention as claimed.

As to claim 2: LeMire discloses an upper and lower arm and connecting portion (fig 3b).

As to claims 3 and 4 : LeMire discloses a connecting portion which permit rolling a ball without contacting the connecting portion (fig 3b).

As to claim 5 : LeMire discloses a length that is substantially the entire length (fig 3b).

As to claim 6 : LeMire discloses upper and lower arms (fig 3b). The specification provides no unexpected or surprising results in using the cited limitations . It would have been obvious to one of ordinary skill in the art to have selected any one of several equivalent roll angles based on the experience of the designer, or cost and design considerations.

As to claims 7-9, 11-13,14-16, : The specification provides no unexpected or surprising results in using the cited limitations . It would have been obvious to one of ordinary skill in the art to select any one of several equivalent roll angles based on the experience of the designer, or cost and design considerations.

As to claim 10 : LeMire discloses a bases and rails (fig 3b).

As to claims 11-12 : LeMire discloses a convex shape (fig 3b). The cross section would naturally be convex in shape. The specification provides no unexpected or surprising results in using the cited limitations. It would have been obvious to one of ordinary skill in the art to select any one of several equivalent roll angles based on the experience of the designer, or cost and design considerations.

As to claim 13 : LeMire discloses a concave shape (fig 3b).

As to claims 18-19: See claim 1 rejection.

Claims 14-17, and 20-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over LeMire as applied to claim 1 above, and further in view of Kohler et al (6916259). Kohler et al discloses the use of projections (fig 3). It would have been obvious to one of ordinary skill in the art to have utilized the projections of Kohler with the device of LeMire in order to provide a deeper pocket for those players who desire a deeper pocket and increase their satisfaction.

As to claim 15 : Kohler discloses projections separated by a width less than the diameter of a lacrosse ball (fig 3).

As to claim 16 : LeMire discloses a semi-oval shape (fig 2,3b).

As to claim 17 : LeMire discloses a molded plastic head (fig 1,3b,9:47-62).

As to claim 24 : See claim 14 rejection.

As to claims 20-22: LeMire discloses a upper and lower arm and connecting portion that can roll a ball without contacting a connecting portion (fig 2, 3b). The specification provides no unexpected or surprising results in using the cited limitations. It would have been obvious to one of ordinary skill in the art to select any one of several equivalent designs based on the experience of the designer, or cost and design considerations.

As to claim 23 : See claim 1 rejection. The length limitation is a design choice. The specification provides no unexpected or surprising results in using the cited limitations. It would have been obvious to one of ordinary skill in the art to select any one of several

equivalent designs based on the experience of the designer, or cost and design considerations.

As to claim 25: Kohler discloses projections separated by a width less than the diameter of a lacrosse ball (fig 3).

As to claim 26 : Kohler discloses a polygon shape(fig 3).

As to claim 27 : LeMire discloses a molded plastic head (fig 1,3b,9:47-62).

### ***Comments***

The applicant is directed to the following section of the MPEP. The specification fails to disclose any surprising or unexpected result from the design modifications to a lacrosse head. Therefore these broad claims with little structural limitations are merely obvious design choices that would be obvious to one of ordinary skill in the art.

M.P.E.P. Section 2144.04

B. Changes in Shape

In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) (The court held that the configuration of the claimed disposable plastic nursing container was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant.).

Although the applicant is welcome to include “boiler plate” comments concerning obviousness rejections, it is strongly recommended that the focus of the response be on what the applicant believes the novelty and non-obviousness of their instant invention is. And how this improvement differs from existing lacrosse heads.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Chambers whose telephone number is 571-272-4407. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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6916259\*20020107094

Michael Chambers  
Examiner  
Art Unit 3711

July 26, 2006

  
EUGENE KIM  
SUPERVISORY PATENT EXAMINER